

## **CLAIM OBJECTIONS**

By the present Amendment, claims 2, 22, and 42 have been cancelled. Therefore, the Applicant respectfully requests the withdrawal of the claim objections since these claims are no longer presented for consideration.

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## **CLAIM REJECTIONS--35 U.S.C. § 101**

Examiner rejects claims 1 and 41 based on 35 U.S.C. § 101. This rejection is respectfully traversed. The Examiner has stated that in regard to claim 1, “the language of the claim raises a question as to whether [it] is directed merely to an abstract idea that is not tied to a technology art, environment or machine.” Further, the Examiner has stated that, in regard to claim 41, “[it] 10 raises issue to whether all of the claimed elements . . . could be implemented in software alone.”

According to MPEP § 2106.IV.B.1 in reference to 35 U.S.C. § 101:

When functional descriptive material (e.g. a data structure) is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function 15 of the descriptive material to be realized. *See also In re Lowry*, 32 F.3d 1579, 158384, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

The MPEP further states that as long as there are “functional interrelationships” between data structures and computer software and hardware, there is statutory language in the claims. By the 20 present Amendment, claims 1 and 41 have been amended to include relationships between the data structures and computer software and hardware. Specifically, claims 1 and 41 currently read in part “test software operating on a computer” and “sending electronic signals.” Therefore, claims 1 and 41 are directed to physical embodiments, meaning statutory subject matter, and the Applicant respectfully requests the withdrawal of the rejection of claims 1 and 41 based on 25 Applicant claiming non-statutory subject matter under 35 U.S.C. § 101.

## **CLAIM REJECTIONS--35 U.S.C. § 102**

Examiner rejected claims 1-6, 8-10, 12-18, 21-26, 28-30, 32-38, 41-46, 48-50, and 52-58 under 35 U.S.C. § 102(e) as being anticipated by Schaefer (U.S. Pat. Application No.

5 2003/0084429 published on 05/01/2003). This rejection is respectfully traversed.

In the Office Action in regard to claims 1, 21, and 41, Examiner states as follows:

“Schaefer teaches a method, system, and computer program product comprising: reading data [in structured format] containing a set of specifications, and translating the data from the structured format into a second format for use in the test software.” (Office Action dated 02/08/2005 at

10 Item 7, p. 3.)

Given the present amendments to claims 1, 21, and 41, the Schaefer prior art reference does not teach every element of the claimed invention. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832,

15 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). None of the prior art references cited teach creating a set of testing instructions which are then subsequently used by testing software to test one or more electrically connected pieces of equipment. Because the cited prior art references do not disclose creating such testing instructions, the present invention is not anticipated.

Further, since all other claims depend from these three independent claims (claims 1, 21, 20 and 41), the other pending claims are likewise not anticipated. Specifically, claims 3-6, 8-10, 12-16, and 18-20 depend from claim 1; claims 22-26, 28-30, and 32-38 depend from claim 21; and claims 42-46, 48-50, and 52-58 depend from claim 41. The Applicant respectfully requests the Examiner to remove the rejection based on anticipation under 35 U.S.C. § 102(b) based on Schaefer.

## **CLAIM REJECTIONS--35 U.S.C. § 103**

Examiner has rejected claims 7, 11, 19-20, 27, 31, 39-40, 47, 51, and 59-60 under 35

5 U.S.C. 103(a) as being unpatentable over Schaefer (US-2003/0084429 05/01/03). This rejection is respectfully traversed.

Given the present amendments to claims 1, 21, and 41, every element of the proposed claims are not found within, nor are obvious variants of, the Schaefer prior art reference.

Applicant would respectfully remind Examiner that all limitations of the claimed invention must  
10 be considered when determining patentability. *See In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994).

The fact that a single claimed element may exist in the prior art does not mean that the claimed combination is obvious in view of the prior art. Examiner must show some suggestion or motivation somewhere in the prior art to make the combination.

15 Applicant requests that Examiner indicate the suggestion or motivation that exists in the prior art that would motivate one with skill in the art to make the combination of “creating a set of testing instructions” and “sending electronic signals to . . . electronic equipment,” as found in the proposed independent claims 1, 21, and 41, with the elements found in the dependent claims 7, 11, 19-20, 27, 31, 39-40, 47, 51, and 59-60. When applying 35 U.S.C. 103, the following tenets of  
20 patent law must be adhered to:

(A) The claimed invention must be considered as a whole;  
(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;  
25 (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and  
(D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141; *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Specifically, Examiner rejected claims 7, 27, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Schaefer. This particular rejection is respectfully traversed. In the Office

5 Action, Examiner states as follows:

10 "Schaefer does not teach wherein the Microsoft spreadsheet file contained a plurality of worksheets. It would have been obvious to one of ordinary skill in the art at the time of the invention for the Microsoft Excel spreadsheets to have had a plurality of worksheets, . . . to group similar data which would have provided the benefit of organizing all the test cases of Schaefer into a single test file."

(Office Action dated 01/05/2004 at p.7.) As claims 7, 27, and 47 ultimately depend from currently amended claims 1, 21, and 41, respectively, these claims now have limitations not considered by the Examiner. Claims 7, 27, and 47 now include the elements of "creating a set of 15 testing instructions" and "sending electronic signals to . . . electronic equipment." These elements make claims 7, 27, and 47 non-obvious over Schaefer. Therefore, Applicant believes claims 7, 27, and 47 are in a state of allowance and should be patentable over Schaefer.

Additionally, Examiner rejected claims 11, 31, and 51 under 35 U.S.C. § 103(a) as being unpatentable over Schaefer. This particular rejection is respectfully traversed. In the Office

20 Action, Examiner states as follows:

"Schaefer does not teach wherein markup language was XML. It would have been obvious to one of ordinary skill in the art at the time of the invention for Schaefer to have used the XML format."

25 (Office Action dated 01/05/2004 at p.7.) As claims 11, 31, and 51 ultimately depend from currently amended claims 1, 21, and 41, respectively, these claims now have limitations not considered by the Examiner. Claims 11, 31, and 51 now include the elements of "creating a set of testing instructions" and "sending electronic signals to . . . electronic equipment." These

elements make claims 11, 31, and 51 non-obvious and over Schaefer. Therefore, Applicant believes claims 11, 31, and 51 are in a state of allowance and should be patentable over Schaefer.

Finally, Examiner rejected claims 19-20, 39-40, and 59-60 under 35 U.S.C. § 103(a) as

being unpatentable over Schaefer. This particular rejection is respectfully traversed. In the

5 Office Action, Examiner states as follows:

10 "Schaefer does not explicitly teach wherein the test specifications where [sic] associated with either a circuit or a power supply. It would have been obvious to one of ordinary skill in the art at the time of the invention for the associated machine of Schaefer to have included a circuit and a power supply, because it was notoriously well known in the art at the time that the associated machine of Schaefer (i.e. personal computer, hand-held device, etc.) would include circuits and a power supply for each of said machines to remain functional."

(Office Action dated 01/05/2004 at p.8.) As claims 19-20, 39-40, and 59-60 ultimately depend

15 from currently amended claims 1, 21, and 41, respectively, these claims now have limitations not considered by the Examiner. Claims 11, 31, and 51 now include the elements of "creating a set of testing instructions" and "sending electronic signals to . . . electronic equipment." The "electronic equipment" referred to is one or more electronic components which are not part of the computer on which the software is executing. These elements make claims 11, 31, and 51

20 non-obvious and over Schaefer. Therefore, Applicant believes claims 11, 31, and 51 are in a state of allowance and should be patentable over Schaefer.

## CONCLUSION

Applicant has read the other prior art cited, but not relied upon, by the Examiner (US 5,905,856 and US 6,002,869). It is respectfully urged that the subject application is patentable over all references cited by Examiner and the pending claims are now in a condition for allowance. Applicant requests consideration of the application and allowance of the claims as now modified. A set of claims as they are now proposed are included with this response. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972-367-2001.

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